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Amendment
Attorney Docket No. S63.2B-10447-US01

Remarks

This Amendment is in response to the Office Action dated **December 1, 2004**. In the Office Action, claims 1-2, 6, 8-9, 11-12, 15-17, 21-24, 26-30 were rejected under 35 USC § 102(e). Claims 1-2, 6, 9-17, 21-24, 26, 29-30 were rejected under 35 U.S.C. 102(e). Claims 25 and 31 were rejected under 35 U.S.C. 103(a). Claims 3-5, 7, 18-20 and 32-33 were rejected under 35 U.S.C. 103(a). Claims 13 and 14 were rejected to as Product by Process Claims.

Applicant has canceled claims 3, 11-12, 19-21, and 29-33 and amended the claims, without prejudice or disclaimer, to secure the prompt issuance of the allowed and allowable subject matter. New claims 34-36 have been added. No new matter has been added.

The paragraph numbers below correspond to those of the Office Action.

1. Oath/Declaration

The Office Action indicates that the Oath/Declaration seems to be missing. The Oath/Declaration was submitted with the electronic application as indicated on the enclosed Transmittal and Acknowledgment Receipt received from the United States Patent and Trademark Office. Nevertheless, Applicant submits herewith a duplicate copy of the Declaration.

2. Specification

Paragraph 84 has been objected to because it was found to be conflicting with respect to the claim dependency. Applicant does not consider there to be any conflict between paragraph 84 and the claims. Nevertheless, to forward the prosecution, Applicant has amended, without prejudice or disclaimer, paragraph 84. Withdrawal of the rejection is requested.

3. Specification

The disclosure has been objected to because of several informalities. Applicant has amended the disclosure as suggested in the Office Action thereby mooting the objections. Paragraphs 3, 11, 15, 18, 28, 29, 36, 46, and 50 have been amended by using the Examiner's suggested wording. Regarding paragraphs 26, 38, and 47, the paragraphs have been amended but

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do differ slightly from the Examiner's suggested wording. Withdrawal of the objections is respectfully requested.

5. 35 USC § 102

Claims 1-2, 6, 8-9, 11-12, 15-17, 21-24, 26-30 are rejected under 35 USC § 102(e) as being anticipated by Cox et al. (6,652,579). Applicant has amended claim 1 to recite in part at least one cover, the at least one cover on at least one region of the medical device, a plurality of the radiopaque markers marking the proximal end of the at least one region and a plurality of the radiopaque markers marking the distal end of the at least one region. Cox does not teach or suggest a covering on the stent, let alone a plurality of radiopaque markers which mark the proximal end of the at least one region and a plurality of the radiopaque markers marking the distal end of the at least one region. For at least this reason, claim 1 and claims 2, 4-10, and 13-14 dependent thereof overcome the rejection in light of Cox.

Applicant has amended claim 16 to recite in part "at least one annular section of interconnected serpentine segments having a proximal and a distal end, there being a plurality of special struts disposed adjacent to the proximal end of the annular section and a plurality of special struts disposed adjacent to the distal end of the annular section".

Cox does not teach or suggest a stent with the above recited combination of features. The figures do not show the necessary plurality of special struts adjacent to the proximal end of the annular segment and the plurality of special struts adjacent to the distal end of the annular segment.

Applicant has amended claim 26 to recite in part "at least one cover, the at least one cover on at least one region of the medical device, a portion of the special struts located at the periphery of the at least one covered region". Cox does not teach or suggest a covering on the stent. For at least this reason claim 26 and claims 2, 4-10, and 13-14 dependent thereof overcome the rejection in light of Cox.

Withdrawal of the anticipation rejection in light of Cox is respectfully requested.

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6. 35 USC § 102

Claims 1-2, 6, 9-17, 21-24, 26, 29-30 are rejected under 35 USC § 102(e) as being anticipated by Wolinsky et al. (6,730,116). As stated above, Applicant has amended claim 1 to recite in part at least one cover, the at least one cover on at least one region of the medical device, a plurality of the radiopaque markers marking the proximal end of the at least one region and a plurality of the radiopaque markers marking the distal end of the at least one region.

Wolinsky et al. does not teach or suggest a covering on the stent, let alone a plurality of radiopaque markers which mark the proximal end of the at least one region and a plurality of the radiopaque markers marking the distal end of the at least one region. Withdrawal of the rejection is respectfully requested.

As stated above, Applicant has amended claim 16 to recite in part "at least one annular section of interconnected serpentine segments having a proximal and a distal end, there being a plurality of special struts disposed adjacent to the proximal end of the annular section and a plurality of special struts disposed adjacent to the distal end of the annular section".

Wolinsky does not teach or suggest a stent with the above recited combination of features. Wolinsky et al. appear to have only one radiopaque marker located at the distal end of the stent and one radiopaque marker located at the proximal end of the stent. For at least this reason claim 16 and claims 17-18 and 22-25 dependent thereof overcome the rejection in light of Wolinsky et al.

Applicant has amended claim 26 to recite in part "at least one cover, the at least one cover on at least one region of the medical device, a portion of the special struts located at the periphery of the at least one covered region". Wolinsky et al. does not teach or suggest a covering on the stent. For at least this reason claim 26 and claims 2, 4-10, and 13-14 dependent thereof overcome the rejection in light of Wolinsky et al..

Withdrawal of the anticipation rejection in light of Wolinsky et al. is respectfully requested.

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8-10. 35 USC § 103

Claims 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Thornton et al. (6,551,350). Claim 16, upon which claim 25 depends, has been amended to recite in part "at least one annular section of interconnected serpentine segments having a proximal and a distal end, there being a plurality of special struts disposed adjacent to the proximal end of the annular section and a plurality of special struts disposed adjacent to the distal end of the annular section".

As indicated above, Cox does not teach or suggest this combination of features. Thornton does not provide this missing limitation. For at least this reason, claim 16 and claim 25 dependent thereof are in condition for allowance.

Claim 31 has been canceled without prejudice or disclaimer.

Withdrawal of the rejection as to claims 25 and 31 is respectfully requested.

11-14. 35 USC § 103

Claims 3-5, 7, 18-20 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinsky in view of Erbel et al. The Office Action refers to Erbel as US 6,730,116. This actually corresponds to Wolinsky. Applicant presumes that the correct number for Erbel is US 20040116998 as referenced in the 892 form accompanying the Office Action. To the extent that another document was intended, Applicant requests clarification in a reissued Office Action.

Claims 3, 19, 20 and 32-33 have been canceled thereby mooted the rejection as to those claims.

As to claims 4 and 5, regardless of whether Erbel teaches cover and regardless of whether it would be obvious to make the proposed combination, the combination of Wolinsky and Erbel does not render obvious the combination of a cover and the recited special struts having radiopaque markers which the proximal end of the at least one region and a plurality of the radiopaque markers marking the distal end of the at least one region.

As to markers 35 of Erbel, they are disposed "at points along the distal edge of non-porous section 25". The markers 35 appear to be part of the stent struts, and no motivation

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is provided to incorporate markers 35 into the struts of the stent, let alone in the manner recited in the claim. Moreover, there is no disclosure of providing the markers 30 which appear to be directly associated with the stent at both ends of the stent. Even if one were to employ the markers of Wolinsky, there is not a plurality of them at the proximal end of the stent and a plurality of them at the distal end of the stent nor is there any suggestion to make such a modification.

15. Product by Process

Claims 13 and 14 are rejected to as Product by Process Claims. Applicant disagrees. Whether it is plated radiopaque material, coated radiopaque material, painted radiopaque material, swaged radiopaque material, or welded radiopaque material there are structural limitations present in each that are not present in the other radiopaque material products. For example, welding thermally transforms the material immediately in the vicinity of the weld such that different properties exist in the material to those that exist in plated material which does not thermally transform the material and in fact leaves the base material substantially unaltered. In addition, swaging cold works the material and physically alters the material without using heat or plating techniques.

Thus the claims are not product by process claims as each claims a different product and the products inherently have different structural limitations.

Withdrawal of the rejection of claims 13 and 14 is respectfully requested.

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Conclusion

In light of the above comments, claims 1-2, 4-10, 13-18, 22-28 and 34 are believed to be in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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By: 
Brendan C. Babcock
Registration No.: 50,705

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001
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